

REMARKS/ARGUMENTS

Claims 4-9 have been added. Support for the new claims may be found throughout the as-filed specification and Figures. No new matter has been added. Reconsideration of this Application and entry of this Amendment are respectfully requested.

Double Patenting Rejection

In the Office Action dated January 10, 2008, claims 1-3 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,905,477 ("the '477 patent") in view of Fischell et al. (U.S. Patent No. 5,334,187). Applicants respectfully traverse this rejection.

Claim 1 recites a catheter and guidewire exchange system that includes, *inter alia*, "a guide member mounted on the proximal shaft and having an outer member and an inner member, the inner member having a catheter passageway extending there through for slidably receiving the catheter shaft and a guide wire passageway for slidably receiving the guide wire for merging the guide wire and the catheter by guiding the guide wire transversely through the guide way and into the first lumen and for separating the guide wire and catheter by guiding the guide wire transversely out of the first lumen through said guide way, the guide member including a keel for tracking the guide way, the outer member being selectively rotatable relative to and around the inner member." As conceded by the Examiner, claims 1 and 2 of the '477 patent do not disclose all of the features of claim 1 of the present application – specifically "the guide member having an outer member and an inner member, the outer member being selectively rotatably [sic] around the inner member." See Office Action at page 3, lines 4-7. The Examiner relies on Fischell et al. to make up for the deficiency.

As an initial matter, Applicant reminds the Examiner that "a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent" and not on what is disclosed in the patent. See MPEP §804 (emphasis added).

The Office Action does not provide any reasoning as to why one of ordinary skill in the art would modify the guide member of claim 1 of the '477 patent to include an outer member that is selectively rotatable relative to and around an inner member of the guide member. Instead, the Office Action cites Fischell et al. as allegedly teaching an inner member (48) and

outer member (63) that is rotatable relative to and around the inner member. *See* Office Action at page 3, lines 7-10. However, as discussed in further detail below, the “inner member” 48 of Fischer et al. does not correspond to the recited inner member of claim 1 of the present application because it does not include all of the features of the inner member of claim 1. If the Office Action is somehow implying that it would be obvious for one of ordinary skill in the art to add the Tuohy-Borst fitting 63 of Fischell et al. to the guide member of claim 1 of the ‘477 patent, it is not clear as to how such a fitting would be used. Is the metal tube 48 of Fischell et al. supposed to be inserted into the distal end of the guide member of claim 1 of the ‘477 patent so that the Tuohy-Borst fitting 63 can be used? If so, the Tuohy-Borst fitting would not be selectively rotatable around the guide member of claim 1 of the ‘477 patent. Although the fitting would be rotatable around the metal tube, the metal tube of Fischell et al. does not include all of the features of the recited inner member of claim 1 of the present application.

In short, Applicant respectfully submits that one of ordinary skill in the art would not be motivated to combine the metal tube and Tuohy-Borst fitting of Fischell et al. with the guide member of claim 1 of the ‘477 patent, especially since claim 1 of the ‘477 patent does not even recite a Y-connector. *See* Office Action at page 3, lns. 10-13 (“It would have been obvious to one having ordinary skill in the art at the time of the invention to securely fit the guide member to a Y-connector and a guide catheter so that a single operator can control the guide wire the Y adaptor and the guiding catheter with only one hand.”) Moreover, even if the parts of Fischell et al. were combined with the guide member of claim 1 of the ‘477 patent, all of the features of claim 1 of the present application would not be present in the combination.

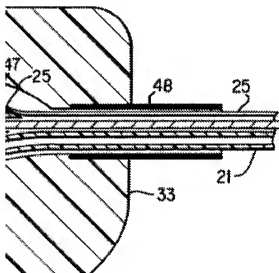
In view of the foregoing, Applicants respectfully submit that claims 1-3 of the present application are not obvious variations of claims 1 and 2 of the ‘477 patent, but instead include features that are not disclosed, taught, or remotely suggested by claims 1 and 2 of the ‘477 patent. Accordingly, Applicants respectfully request that the rejection of claims 1 and 2 be withdrawn.

35 U.S.C. §102 Rejection

In the Office Action, claims 1-3 were rejected under 35 U.S.C. §102(b) as being anticipated by Fischell et al. Applicant respectfully traverses this rejection.

Claim 1 recites a catheter and guide wire exchange system that includes, *inter alia*, “a guide member mounted on the proximal shaft and having an outer member and an inner member, the inner member having a catheter passageway extending there through for slidably receiving the catheter shaft and a guide wire passageway for slidably receiving the guide wire for merging the guide wire and the catheter by guiding the guide wire transversely through the guide way and into the first lumen and for separating the guide wire and catheter by guiding the guide wire transversely out of the first lumen through said guide way, the guide member including a keel for tracking the guide way, the outer member being selectively rotatable relative to and around the inner member.” Applicant respectfully submits that Fischell et al. does not disclose, teach, or suggest all of the features of claim 1.

Fischell et al. discloses a balloon angioplasty catheter system that includes a flexible guide wire, balloon catheter, and slide handle. *See* Fischell et al. at Abstract. The Office Action has construed the metal tube 48 of Fischell et al. as being the recited inner member of the guide member. *See* Office Action at page 4, line 17. A portion of FIG. 4C of Fischell is reproduced below, with the metal tube 48 filled in for illustration purposes.



As clearly shown in FIG. 4C (above), the metal tube 48 does not have “a guidewire passageway for slidably receiving the guide wire for merging the guide wire and the catheter by guiding the guide wire transversely through the guide way and into the first lumen and for separating the guide wire and catheter by guiding the guide wire transversely out of the first

lumen through said guide way.” Instead, the metal tube 48 of Fischell et al. has a single passageway that is configured to receive the catheter body shaft 21. See Fischell et al. at FIG. 4C (and above). Although the catheter body shaft 21 has a guide wire lumen 22, see Fischell et al. at FIG. 2 and col. 3, lns. 39-42, the lumen 22 does not merge the guide wire and the catheter by guiding the guidewire transversely through the guide way and into the first lumen (i.e., itself), as recited by claim 1. In other words, the metal tube 48 of Fischell et al. cannot be construed to be the recited inner member of claim 1, because the metal tube 48 does not have all of the features of the inner member that are recited by claim 1.

In view of the foregoing, Applicants respectfully submit that claim 1 and the claims that depend from claim 1 and include additional advantageous features, are patentable over Fischell et al., and respectfully request that the rejection of claims 1-3 be withdrawn.

New claims 4-9 are patentable for their dependency from claim 1, as well as for the additional advantageous features recited therein.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-0221.

Respectfully submitted,

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